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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,889	04/10/2001	Toshio Yagihashi	Q63958	7824

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,889

Applicant(s)

YAGIHASHI ET AL.

Examiner

Cristina Owen Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-27 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d)-or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the after-final amendment filed June 10, 2005. Claims 1-27 are pending in this case.

Response to Arguments

2. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keane et al (US 2004/0046788).

5. Regarding claims 1, and 18-21 –

Keane discloses a network-based service system, comprising database server for storing a database containing information on samples that are registered in advance via a network; terminal to search said database and conduct design of the device (e.g. par 0010, 0022, 0024,), and account terminal for making a payment for utilizing the database from the bank account of the user to the bank account of the vendor upon utilization of database (e.g. par 0084), and the database supplying information on parts, vendors, and sending payments to vendors or designers (e.g. par 0007, 0127, 0097).

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6. Keane does not specify designing circuits or antinoise circuits *per se*, however, it would be obvious to one of ordinary skill in the art to adapt Keane for use in any design job, such as circuits, furniture, etc.

7. Regarding claim 2 –

Keane discloses the network-based design service system as set forth in claim 1, wherein said terminal searches said database on a WWW site, and conducts a project (e.g. par 0050).

8. Regarding claim 3 –

Keane discloses the network-based service system as set forth in claim 1, wherein said account terminal has a function for paying an employment fee from a bank account of a parts vendor to the bank account of the user upon employment of the database (e.g. par 0084).

9. Regarding claim 4 –

Shear discloses the network-based service system as set forth in claim 1, comprising: means for notifying other terminals if a problem is found in a sample during the process (e.g. par 0100).

10. Regarding claim 5 –

Keane discloses the network-based service system as set forth in claim 1, comprising: means for the user to conduct design, and determine parts to employ through price simulation for meeting a target price (e.g. par 0055).

11. Regarding claim 6 –

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Keane discloses the network-based service system as set forth in claim 1, comprising means for notifying other terminals if a problem is found during the process for the device; and means design for the device, and determine parts to employ through price simulation for meeting a target price (e.g. par 0100).

12. Keane does not expressly a database for use in field of designing circuits. However, these differences are found only in the non-functional data stored in the database. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F2d 1381, 1385, 217 USPQ 401,404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579,32 USPQ2d 1031 (Fed.Cir.1994).

13. Claims 7-12 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keane et al (US 2004/0046788).

14. Regarding claims 7 and 22-24 –

Keane discloses a network-based design method, comprising the steps of a vendor registering on a database server various kinds of information, in advance via a network; a user searching said database, determining conditions autonomously, and conducting the design of a device; and paying a royalty for utilizing the database from the bank account of the user to the bank account of the vendor upon utilization of said design database (e.g. par 0084), and the database supplying information on parts, vendors, and sending payments to vendors or designers (e.g. par 0007, 0127, 0097).

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15. Keane does not specify designing circuits or antinoise circuits *per se*, however, it would be obvious to one of ordinary skill in the art to adapt Keane for use in any design job, such as circuits, furniture, etc.

16. Regarding claim 8 –

Keane discloses the network-based method as set forth in claim 7, wherein said design step searches said database on a WWW site and conducts the design of a device (e.g. par 0010, 0022, 0024,).

17. Regarding claim 9 –

Keane discloses the method of claim 7, further comprising the step of paying an employment fee from a bank account of the vendor to the bank account of the user upon employment of a data by said user (e.g. par 0084).

18. Regarding claim 10 –

Keane discloses the network-based method as set forth in claim 7, comprising the step of notifying other terminals if a problem is found during the design process for the device (e.g. par 0100).

19. Regarding claim 11 –

Keane discloses the network-based method as set forth in claim 7, comprising the step of the user conducting design for the device, and determining parts to employ through price simulation for meeting a target price (e.g. par 0055).

20. Regarding claim 12 –

Keane discloses the network-based method as set forth in claim 7, comprising the steps of notifying other terminals if a problem is found in a sample; and the designer

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conducting circuit design for the device, and determining parts to employ through price simulation for meeting a target price (e.g. par 0100).

21. Keane does not expressly a database for use in field of designing circuits.

However, these differences are found only in the non-functional data stored in the database. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *Cf. In re Gulack*, 703 F2d 1381, 1385, 217 USPQ 401,404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579,32 USPQ2d 1031 (Fed.Cir.1994).

22. Claims 13-17 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear (US 5,410,598A) in view of Peters (WO02097705).

23. Regarding claims 13 and 25-27 –

Keane discloses a network-based service system, comprising database server for storing a database containing information that are registered by a vendor in advance via a network; and terminal for a user to search said database, determine conditions autonomously, and conduct the project (e.g. par 0010, 0022, 0024,), and the database supplying information on parts, vendors, and sending payments to vendors or designers (e.g. par 0007, 0127, 0097).

24. Keane does not specify designing circuits or antinoise circuits *per se*, however, it would be obvious to one of ordinary skill in the art to adapt Keane for use in any design job, such as circuits, furniture, etc.

25. Regarding claim 14 –

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Keane discloses the network-based service system as set forth in claim 13, wherein said user terminal searches said database on a WWW site, and conducts the project (e.g. par 0010, 0022, 0024,).

26. Regarding claim 15 –

Keane discloses the network-based service system as set forth in claim 13, comprising means for notifying other terminals if a problem is found during the process (e.g. par 0100).

27. Regarding claim 16 –

Keane discloses the network-based design service system as set in claim 13, comprising means for the designer to conduct circuit design for the device and determine parts to employ through price simulation for meeting a target price and noise simulation for achieving a required noise proof performance (e.g. par 0100).

28. Regarding claim 17 –

Keane discloses the network-based service system as in claim 13, comprising means for notifying other terminals if a problem is found during the process and determine parts to employ through price simulation for meeting a target price (e.g. par 0100).

29. Keane does not expressly a database for use in field of designing circuits.

However, these differences are found only in the non-functional data stored in the database. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579,32 USPQ2d 1031 (Fed.Cir.1994).

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30. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

32. Shear (US 5,410,598) discloses a database usage metering and protection system and method.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ferrin Arch
Primary Examiner